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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,452

11/26/2003

Richard Hoffman

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SCHWARTZ COOPER CHARTERED
IP DEPARTMENT
180 NORTH LASALLE STREET
SUITE 2700
CHICAGO, IL 60601

EXAMINER

WONG, ALLEN C

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

07/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/723,452	Applicant(s) HOFFMAN ET AL.	
	Examiner Allen Wong	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/3/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 25-32 in the reply filed on 7/12/07 is acknowledged. The traversal is on the ground(s) that Species 1, Figure 1 (Claims 25-32), Species 2, Figure 2 (33-34) and Species 3, Figure 3 (1-24) are the same. After careful and respectful consideration to applicant's remarks, this is not found persuasive because in each species, there are different embodiments in that Species 1, pertaining to claims 25-32 involve audio/visual data transmission from one location to the second location as illustrated in Figure 1, Species 2 pertaining to claims 33-34 are very specific in that it shows the specifics in Figure 2, and Species 3 pertaining to the claims 1-24 that shows the specifics of Figure 3. Thus, all of the claims as divided up in the election/restriction requirement of the previous Office Action have been reasonably met.
2. Claims 1-24 and 33-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species 2 and 3, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Art Unit: 2621

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 29-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 29 defines "*a method for providing instruction between two persons*" embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed "a method providing instruction between two persons" can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the preamble of the claim to disclose "a computer readable medium encoded with computer

Art Unit: 2621

executable instructions for..." in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 25-27 and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Palmer (5,831,666).

Regarding claims 25 and 29, Palmer discloses a method for communicating between a first and second location, comprising:

providing for, from a first location, transmitting audio and visual information to a person at a second location (fig.1, the lower-left workstation 12 is considered a first location and the upper-right workstation 12 is the second location, wherein each workstation has a camera 38 that can be used for providing video data from one location to another location and vice-versa, and headset 48, wherein col.5, ln.48-50, the microphone 46 can be connected to the headset 48 for providing audio data from one location to another location and vice-versa);

providing for, from the second location, transmitting audio information to a person at the first location (fig.1, note the upper-right workstation 12 is located at the second location in that headset 48 can provide and transmit audio data to a person in the lower-left workstation 12 located in the first location, wherein col.5, ln.48-50, the

microphone 46 can be connected to the headset 48 for providing audio data from one location to another location and vice-versa).

Regarding claims 26 and 30, Palmer discloses further comprising: providing for, from the second location, transmitting video information to a person at the first location (fig.1, note the upper-right workstation 12 is located at the second location in that camera 48 can provide and transmit video data to a person in the lower-left workstation 12 located in the first location).

Regarding claims 27 and 31, Palmer discloses further comprising: providing for storing the audio and video information transmitted between the first and second locations in a retrievable storage device (col.3, ln.27-32, col.5, ln.1-5 and ln.42-44, col.14, ln.60 to col.15, ln.ln.66, note the audio and video data can be stored in a plurality of ways like storing audio/visual data file (MPEG), VCR, video disk format, etc.).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer (5,831,666) in view of Thomason (6,317,039).

Regarding claims 28 and 32, Palmer discloses a device that provides audio and visual data at the first location (fig.1, note at the lower-left workstation 12 is considered

Art Unit: 2621

a first location, where headset 48 provides audio data, wherein col.5, ln.48-50, the microphone 46 can be connected to the headset 48 for providing audio data from one location to another location and vice-versa, and that element 38 is a video camera that provides video data). Although Plamer does not specifically disclose the audiovisual device is positioned about the head of the person, however, it would have been obvious to modify and merge Palmer's headset with the video camera together for providing an audiovisual device as seen in the industry for conveniently providing audio and video data in one lightweight unit so as to fully capture all of the audio and video data during sporting events, teleconferencing, etc. Thomason teaches the use of a audiovisual device is positioned about the head of the person (fig.4 and col.7, ln.1-25; Thomason discloses the use of a video camera 105 positioned about the head of the person 102 and 138 is an audio/video transceiver that permits the transmission of audiovisual data back and forth from one location to the second location for two-way audiovisual communication). Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of Palmer and Thomason as a whole for conveniently transmitting and receiving audiovisual data in one lightweight apparatus for news or sports reporting events, teleconferencing and other wireless communication applications.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen Wong whose telephone number is (571) 272-7341.

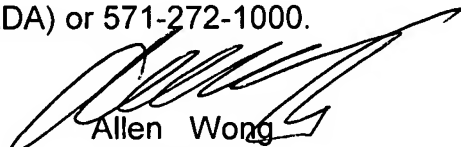
Art Unit: 2621

The examiner can normally be reached on Mondays to Thursdays from 8am-6pm

Flextime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Allen Wong
Primary Examiner
Art Unit 2621

AW
7/23/07